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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/389,537	09/02/1999	PATRICK V. WARREN	DIVER1240-3	5543
20985	7590	12/31/2003	EXAMINER	
FISH & RICHARDSON, PC 12390 EL CAMINO REAL SAN DIEGO, CA 92130-2081			SLOBODYANSKY, ELIZABETH	
			ART UNIT	PAPER NUMBER
			1652	

DATE MAILED: 12/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/389,537

Applicant(s)

WARREN ET AL.

Examiner

Elizabeth Slobodyansky

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 17-49 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

The amendment filed October 6, 2003 amending claims 17-43 and adding claims 44-49 has been entered.

The Declaration under 37 C.F.R. § 1.132 by Dr. Jay Short filed October 6, 2003 has been entered.

Claims 17-49 are pending.

Upon further consideration in view of the amendment the following restriction is required.

### ***Election/Restriction***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 17-27, 44-49 (all in part) and claims 28, 29 drawn to an aspartate transaminase A of SEQ ID NO:25 and a method of use thereof, classified in class 435, subclass 15.
- II. Claims 17-27, 44-49 (all in part) and claims 30, 37, drawn to an aspartate transaminase B of SEQ ID NO:26 and a method of use thereof, classified in class 435, subclass 15.
- III. Claims 17-27, 44-49 (all in part) and claims 31, 38, drawn to an adenosyl-8-amino-7-oxononanoate aminotransferase of SEQ ID NO:27 and a method of use thereof, classified in class 435, subclass 15.

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- IV. Claims 17-27, 44-49 (all in part) and claims 32, 39, drawn to an acetylornithine aminotransferase of SEQ ID NO:28 and a method of use thereof, classified in class 435, subclass 15.
- V. Claims 17-27, 44-49 (all in part) and claims 33, 40, drawn to an aspartate aminotransferase of SEQ ID NO:29 and a method of use thereof, classified in class 435, subclass 15.
- VI. Claims 17-27, 44-49 (all in part) and claims 34, 41, drawn to a glucosamine:fructose-6-phosphate aminotransferase of SEQ ID NO:30 and a method of use thereof, classified in class 435, subclass 15.
- VII. Claims 17-27, 44-49 (all in part) and claims 35, 42, drawn to a histidinol-phosphate aminotransferase of SEQ ID NO:31 and a method of use thereof, classified in class 435, subclass 15.
- VIII. Claims 17-27, 44-49 (all in part) and claims 36, 43, drawn to a branched chain aminotransferase of SEQ ID NO:32 and a method of use thereof, classified in class 435, subclass 15.

The inventions are distinct, each from the other because of the following reasons:

Inventions I-VIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In

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the instant case the different inventions I-VIII are drawn to aminotransferases/transaminases having different structures and different functions, i.e. catalyzing different reactions. As such they have different effects and, therefore, different utilities. Each transaminase can be used in the production of a specific product not produced by the action of the other transaminase.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

A telephone call was made to Mr. Gregory Einhorn on December 22, 2003 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

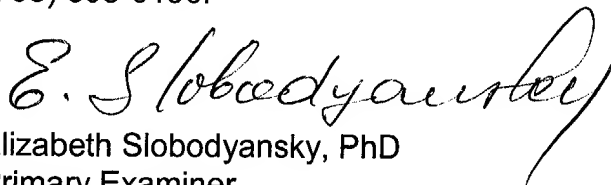
Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(l).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth Slobodyansky whose telephone number is (703) 306-3222. The examiner can normally be reached Monday through Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Ponnathapura Achutamurthy, can be reached at (703) 308-3804. The FAX phone number for Technology Center 1600 is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Center receptionist whose telephone number is (703) 308-0196.

A handwritten signature in cursive script, reading "E. Slobodyansky". The signature is written in black ink and is positioned above the printed name and title.

Elizabeth Slobodyansky, PhD  
Primary Examiner

December 22, 2003